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APPLICANT: David N. Harris CONFIRMATION NO.: 2653
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TRANSACTIONS
EXAMINER: Ms. Raquel Alvarez
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CERTIFICATE OF MAILING

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APPEAL BRIEF

Dear Sir:

This paper is in support of a notice of appeal filed herewith, which is in response to the non-final office action having a mailing date of May 1, 2007. A three-month extension of time is included herewith, extending the deadline for the notice of appeal until November 1, 2007.

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Real Party in Interest

David N. Harris

Related Appeals and Interferences

None.

Status of Claims

Claims 1-3 and 5-36 are pending. Claims 1-3, 5-7, 9-11, 13-21 and 23-24 stand rejected and are on appeal. Claims 8, 12, 22 and 25-36 were not rejected or addressed in the office action and are assumed, therefore, to recite allowable subject matter. Thus, assuming claims 8, 12, 22 and 25-36 are not rejected, Applicant is not appealing those claims. However, if claims 8, 12, 22 and 25-36 stand rejected, then Applicant is appealing those claims also.

Status of Amendments

The current office action is non-final. Thus, no amendments after final have been filed.

Summary of Claimed Subject Matter

Independent claim 1 defines a computer system (page 6, lines 3-11; page 23, lines 10-17; element 200 in Fig. 2; element 200A in Fig. 11) for verifying a commercial transaction between a user with credit card information and a merchant (page 11, lines 22 to 31; line page 23, line 28 to page 24, line 4, element 104 of Fig. 1). The system includes a processing unit (page 6, lines 3-11, element 202 in Fig. 2 and element 202 in Fig. 11) for processing data and code and memory (page 10, lines 8-10, page 10, line 28 to page 11, line 8, element 216 in Fig. 2 and element 216 in Fig. 11) for storing said data and said code, said data and said code comprising a merchant communications module (page 10, line 28 to page 11, line 3, page 10, lines 22 to 31; element 232 in Fig. 2 and element 232 in Fig. 11) operative to facilitate a connection with the merchant for receiving a transaction approval request. The transaction approval request (page 12, line 26 to page 13, line 7, element 402(1-n) in Fig. 4) includes information to identify an account-holder 102 associated with the credit card information. At least one pre-verification condition (page 24, line 15 to page 25, line 7, element 1302 (1-n) in Fig. 13) is associated with said account-holder. The pre-verification condition defines a pre-verified circumstance when account-holder verification is not needed (page 23, lines 15-17). An authorization module element (226A in Fig. 11) is responsive to the transaction approval request and operative to compare the transaction approval request with the at least one pre-verification condition, to verify the transaction approval request without account-holder verification if the at least one pre-verification condition is satisfied, and to verify the transaction approval request with the account-holder if the at least one pre-verification condition is not satisfied (page 23, lines 10 to 17). An account-holder communication module (page 27, lines 26-29; element 306 in Fig. 3; 306A in Fig. 16) is operative to enable the account-holder to set the pre-verification condition, so that the account-holder can specify the circumstances when account-holder verification is not needed (page 11, lines 17-20; page 27, lines 27-29).

Independent claim 13 is directed to a method for verifying a commercial transaction between a user with credit card information and a merchant (page 11, lines 22 to 31; page 23, line 28 to page 24, line 4). The method includes storing at least one pre-verification condition (page 24, line 15 to page 25, line 7, element 1302(1-n) in Fig. 13) for an account-holder (element

102 of Fig. 1) associated with the credit card information (page 23, lines 18-27), with the pre-verification condition defining a pre-verified circumstance when account-holder verification is not needed (page 23, line 15-17), and receiving a transaction approval request from the merchant. (page 19, lines 21-23, element 702 on Fig. 7) The transaction approval request includes information to identify the account-holder. The transaction approval request is compared to the pre-verification condition. (Page 25, lines 17-19, element 809 of Fig. 14) The transaction approval request is verified without account-holder verification if the pre-verification condition is met (page 25, lines 24-26); and the transaction approval request is verified with the account-holder if the pre-verification condition is not met (page 25, lines 19-23).

Grounds of Rejection to be Reviewed on Appeal

Whether claims 1-3, 5-7, 9-11, 13-21 and 23-24 are anticipated under 35 U.S.C. 102(b) over U.S. Pat. No. 5,708,422 to Blonder (hereinafter referred to as Blonder). If claims 8, 12, 22 and 25-36 are rejected, then also whether claims 8, 12, 22 and 25-36 are anticipated under 35 U.S.C. 102(b) over Blonder.

Argument

A few Relevant Provisions on Patentability:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), cert. denied, 484 U.S. 827 (1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

Examiner's Rejection:

In the office action dated May 1, 2007, the Examiner rejected claims 1-3, 5-7, 9-11, 13-21 and 23-24 under 35 USC § 102 as anticipated by *Blonder*. Specifically, the Examiner states,

Blonder teaches a computer system and corresponding computer method for verifying a commercial transaction between a user with credit card information and a merchant. A processing unit for processing data and code and a memory for storing data and said code, said data and said code comprising a merchant communications module to connect with the merchant for receiving a transaction approval request said transaction request (Figure 1, col. 2, lines 60-65; col. 4, lines 55-65, col. 5, lines 5-10), including information to identify an account holder associated with said credit card information (figure 3), and code further including an authorization module responsive to the transaction approval request to compare the request with the pre-verification condition said pre-verification condition defining a pre-verified circumstance when account holder verification

is not needed and to verify the request if the criteria is satisfied (Figure 3).
Blonder also teaches a plurality of verification criteria are satisfied (Figure 3), the criteria are determined by the account holder (Figure 3), receive and establish a connection with the account holder, authenticate the account holder, present at least one criteria to the account holder, and receive modification instructions from the account holder (col. 7, lines 65 to col. 9, line 30), the pre-verification criteria includes at least one merchant identifier (Figure 9) for comparing and verifying the merchant associated with the transaction, the pre-verification criteria includes a maximum purchase price (Figure 9) for comparison and verification of the transaction; criteria include a begin and end date for comparison and verification of the transaction (Figure 9); to verify said transaction approval request if said at least one pre-verification criteria is satisfied (i.e. verifying that the transaction approval request and the pre-verification criteria are matched and satisfied) (Figure 3); to verify said transaction approval request with said account holder if said at least one pre-verification criteria is not satisfied (i.e. if pre-verification is not satisfied then contacting the customer for approval (see figure 1, 135).

With respect to the newly added limitation of an account-holder communication module operative to enable the account-holder to said pre-verification condition, so that said account-holder can specify the circumstances when account-holder verification is not needed (i.e. the account holder John Smith specifies that on transactions less than 100, no verification is needed) (see Figure 3).

(See Office action page 3, last paragraph).

Blonder Reference:

Blonder teaches that account owner approval *is required* when the pre-established condition *is satisfied*. See Figure 3 and col. 5, line 66 to column 6, line 27. This is specifically shown by records 1-3 of Fig. 3; and described in col. 6, lines 15-24.

Referring to the first record (row 1) of Figure 3, col. 6, lines 15-18 states, “For example, the first record indicates that the card owner wishes to be alerted whenever a cardholder charges more than one hundred (100) dollars to the credit card number.” Thus, per Blonder, the “YES” alert flag of record 1 indicates that an alert is needed when the condition is met, namely, the charge is greater than \$100. And, the “NO” approval flag of record 1 indicates that card owner approval is not needed whether or not the condition is met.

Referring to the second record (row 2) of Figure 3, col. 6, lines 18-20 states, “The third [sic, second] record illustrates that the card owner wishes to authorize any credit card transaction for more than three hundred dollars.” Thus, per Blonder, the “YES” alert flag of record 2 indicates that an alert is needed when the condition is met, namely, the charge is greater than \$300. And, the “YES” approval flag of record 2 indicates that card owner approval is needed when the condition is met.

Referring to the third record (row 3) of Figure 3, col. 6, lines 20-24 states, “By contrast, the owner of the credit card number associated with the third record wishes to be alerted whenever that card is used at commercial establishments associated with specific merchant codes.” Thus, per Blonder, the “YES” alert flag of record 3 indicates that an alert is needed when the condition is met, namely, that the card is being used at an establishment that corresponds to the merchant codes 1234 or 4567. And, the “NO” approval flag of record 3 indicates that card owner approval is not needed whether or not the condition is met.

Rejection under 35 USC § 102(b) of Claims 1-3, 5, 6, 9-11, 13-18, 21 and 23-24

Claim Limitations:

Independent claim 1 requires, in relevant part, the following three claims elements:

- “at least one pre-verification condition associated with said account-holder, said pre-verification condition defining a pre-verified circumstance when account-holder verification is *not* needed” [i.e., the “pre-verification condition”]
- “an authorization module responsive to said transaction approval request and operative... to verify said transaction approval request *without* account-holder verification if said at least one pre-verification condition is satisfied” [i.e., the response to the satisfaction of the pre-verification condition]
- “an authorization module responsive to said transaction approval request and operative... to verify said transaction approval request *with* said account-holder if said at least one pre-verification condition is not satisfied” [i.e., the response to the failure of the pre-verification condition]

Similarly, independent claim 13 requires the following three claim elements:

- “storing at least one pre-verification condition for an account-holder associated with said credit card information, said pre-verification condition defining a pre-verified circumstance when account-holder verification is *not* needed;” [i.e., the “pre-verification condition”]
- “verifying said transaction approval request *without* account-holder verification if said pre-verification condition is met; and” [i.e., the response to the satisfaction of the pre-verification condition]

- “verifying said transaction approval request *with* said account-holder if said pre-verification condition is not met.” [i.e., the response to the failure of the pre-verification condition]

Each of claims 1 and 13 requires a “pre-verification condition,” which as claimed is defined as “a pre-verified circumstance when account-holder verification is *not* needed.” Thus, the independent claims require that, *upon satisfaction of the pre-verification condition*, account holder approval is *not* needed. Still further, claim 1 includes a module and claim 13 includes steps that recite(s) the response to satisfaction of the pre-verification condition and the response to a failure of the pre-verification condition. That is, both claims 1 and 13 require account-holder verification when the pre-verification condition is *not satisfied* and automatic verification when the pre-verification condition is *satisfied*.

Differences:

Blonder seeks card owner approval upon satisfaction of the condition. However, claims 1 and 13 each require approval of the transaction “*without* account holder verification” upon satisfaction of the condition, in direct contrast to Blonder.

Similarly, Blonder does not seek card owner approval upon failure of the condition. However, claims 1 and 13 each require approval of the transaction “*with* account holder verification” upon failure of the condition, again, in direct contrast to Blonder.

Significance of Differences:

Most importantly, the claimed invention enables a new application otherwise unavailable from the teachings of Blonder. For example, the claimed invention enables automatic approval of transactions with one merchant, while still requiring account holder approval of transactions with all other merchants. To accomplish this embodiment, since Blonder requires card owner approval whenever its condition is satisfied, Blonder would need to store the merchant codes of

all existing unauthorized merchants as its condition. That way, the one remaining authorized merchant, who is not listed as a Blonder condition, would be automatically approved. Such a feat in Blonder would be effectively impractical, if not impossible. However, according to the claimed invention, the pre-authorized merchant code alone could be stored as the pre-verified condition. Thus, all transactions with the pre-authorized merchant would be approved without account-holder verification, and transactions with all other merchants would require account holder verification.

Summary:

Accordingly, because of at least these differences, Appellant respectfully submits that the 35 USC § 102 rejection of claim 1 and claim 13 should be withdrawn. Further, since claims 2, 3 and 5, 6 and 9-11 depend from claim 1 and claims 14-18, 21, 23 and 24 depend from claim 13, Applicant respectfully submits that claims 5, 6, 9-11, 14-18, 21, 23 and 24 are distinguished for at least the same reasons.

Rejection under 35 USC § 102(b) of Claims 7 and 19

In addition to the reasons described above with reference to claims 1 and 13 from which these claims depend, Applicant respectfully submits that claims 7 and 19 are patentable over Blonder for the following additional reasons:

Claim Limitations:

Claim 7 recites, in relevant part,

- “wherein said pre-verification condition includes at least one merchant identifier”

Claim 19 recites, in relevant part,

- “wherein said pre-verification condition includes at least one merchant identifier”

Differences:

Claims 7 and 19 require the pre-verification condition specifically to include at least one merchant identifier. Accordingly, per the limitations of the independent claims, that merchant identifier defines a pre-verified circumstance when account holder approval is *not* needed. This is directly opposite of the teachings of Blonder, Figure 3, record 3.

Summary:

Accordingly, because of at least these differences, Appellant respectfully submits that the 35 USC § 102 rejection of claims 7 and 19 should also be withdrawn.

Rejection under 35 USC § 102(b) of Claim 20

In addition to the reasons described above with reference to claims 13 and 19 from which this claim depends, Applicant respectfully submits that claim 20 is patentable over Blonder for the following additional reasons:

Claim Limitations:

Claim 20 recites, in relevant part,

- “wherein: said pre-verification condition includes a plurality of merchant identifiers; said transaction approval request is verified if said merchant is identified by one of said plurality of merchant identifiers”

Differences:

Claim 20 requires the pre-verification condition to include multiple merchant identifiers and the responsive action of verifying the transaction approval request *without* account holder approval when the transaction is occurring at an establishment of one of the merchants identified by the multiple merchant identifiers. Again, this is directly opposite of the teachings of Blonder, Figure 3, record 3.

Summary:

Accordingly, because of at least these differences, Appellant respectfully submits that the 35 USC § 102 rejection of claim 20 should also be withdrawn.

Claims 8, 12, 22 and 25-36

The Examiner did not indicate the status of claims 8, 12, 22 or 25-36 and did not address the claims in her response whatsoever.

Accordingly, Appellant respectfully submits that the Examiner failed her burden to show a prima facie case against claims 8, 12, 22 and 25-36. Accordingly, Appellant respectfully submits that claims 8, 12, 22 and 25-36 should be found to recite allowable subject matter if placed into independent form.

However, if claims 8, 12, 22 and 25-36 are deemed to be rejected, then Appellant respectfully submits that the rejection should be withdrawn for at least the reasons set forth with reference to claims 1 and 13, since claims 8 and 12 depend from claim 1 and claims 22 and 25-36 depend from claim 13.

Claims Appendix

1. A computer system for verifying a commercial transaction between a user with credit card information and a merchant, said computer system comprising:

a processing unit for processing data and code; and
memory for storing said data and said code, said data and said code comprising
a merchant communications module operative to facilitate a connection with said merchant for receiving a transaction approval request, said transaction approval request including information to identify an account-holder associated with said credit card information,
at least one pre-verification condition associated with said account-holder, said pre-verification condition defining a pre-verified circumstance when account-holder verification is not needed,
an authorization module responsive to said transaction approval request and operative to compare said transaction approval request with said at least one pre-verification condition, to verify said transaction approval request without account-holder verification if said at least one pre-verification condition is satisfied, and to verify said transaction approval request with said account-holder if said at least one pre-verification condition is not satisfied, and
an account-holder communication module operative to enable the account-holder to set said pre-verification condition, so that said account-holder can specify the circumstances when account-holder verification is not needed.

2. A computer system according to Claim 1, wherein:

said at least one pre-verification condition includes a plurality of pre-verification conditions; and
said authorization module is operative to verify said transaction approval request if at least one of said plurality of pre-verification conditions is satisfied.

3. A computer system according to Claim 1, wherein:
 - said at least one pre-verification condition includes a plurality of pre-verification conditions; and
 - said authorization module is operative to verify said transaction approval request only if all of said plurality of pre-verification conditions are satisfied.
5. A computer system according to Claim 1, wherein said account-holder communications module is operative to:
 - receive a connection request from said account-holder;
 - establish a connection with said account-holder;
 - authenticate said account-holder;
 - present said at least one pre-verification condition to said account-holder; and
 - receive modification instructions for said said at least one pre-verification condition from said account holder.
6. A computer system according to Claim 5, wherein, prior to receiving said modification instructions from said account-holder, said pre-verification condition is not satisfied.
7. A computer system according to Claim 1, wherein said pre-verification condition includes at least one merchant identifier.
8. A computer system according to Claim 7, wherein said authorization module, responsive to receipt of said transaction approval request, is operative to:
 - compare said merchant transmitting said transaction approval request with each of said merchant identifiers; and
 - verify said transaction approval request if said merchant sending said transaction approval request is identified by one of said merchant identifiers.
9. A computer system according to Claim 1, wherein said pre-verification condition includes a pre-verified purchase price.

10. A computer system according to Claim 9, wherein said authorization module, responsive to receipt of a transaction approval request is operative to:

compare a purchase price contained within said transaction approval request with said pre-verified purchase price; and
verify said transaction approval request if said purchase price contained within said transaction approval request is less than said pre-verified purchase price.

11. A computer system according to Claim 1, wherein said pre-verification condition includes a begin date and an end date.

12. A computer system according to Claim 11, wherein said authorization module, responsive to receipt of said transaction approval request, is operative to:

compare a purchase date contained within said transaction approval request with said begin date and said end date; and
verify said transaction approval request if said purchase date falls between said begin date and said end date.

13. In a computer system, a method for verifying a commercial transaction between a user with credit card information and a merchant, said method comprising:

storing at least one pre-verification condition for an account-holder associated with said credit card information, said pre-verification condition defining a pre-verified circumstance when account-holder verification is not needed;
receiving a transaction approval request from said merchant, said transaction approval request including information to identify said account-holder;
comparing said transaction approval request to said pre-verification condition;
verifying said transaction approval request without account-holder verification if said pre-verification condition is met; and
verifying said transaction approval request with said account-holder if said pre-verification condition is not met.

14. A method according to Claim 13, wherein:
 - said step of storing at least one pre-verification condition includes storing a plurality of pre-verification conditions; and
 - said step of verifying said transaction approval request includes verifying said transaction approval request if at least one of said pre-verification conditions is satisfied.
15. A method according to Claim 13, wherein:
 - said step of storing at least one pre-verification condition includes storing a plurality of pre-verification conditions; and
 - said step of verifying said transaction approval request includes verifying said transaction approval request only if all of said pre-verification conditions are satisfied.
16. A method according to Claim 13, wherein said at least one pre-verification condition is determined by said account-holder.
17. A method according to Claim 13, further comprising:
 - establishing a connection with said account-holder;
 - authenticating said account-holder; and
 - allowing said account-holder to modify said pre-verification condition associated with said account-holder.
18. A method according to Claim 17, wherein, said pre-verification condition is not satisfied prior to modification by said account-holder.
19. A method according to Claim 13, wherein said pre-verification condition includes at least one merchant identifier.

20. A method according to Claim 19, wherein:
said pre-verification condition includes a plurality of merchant identifiers;
said transaction approval request is verified if said merchant is identified by one of
said plurality of merchant identifiers.
21. A method according to Claim 13, wherein said pre-verification condition includes a
pre-verified purchase price.
22. A method according to Claim 21, wherein said transaction approval request is
verified if a purchase price identified in said transaction approval request is less than said pre-
verified purchase.
23. A method according to Claim 13, wherein said pre-verification condition includes at
least one pre-verification date.
24. A method according to Claim 23, wherein:
said pre-verification condition includes at least one pair of pre-verification dates; and
said transaction approval request is verified if a transaction date included in said
transaction approval request falls between said pre-verification dates.
25. A computer-readable medium having code embodied therein for causing an
electronic device to perform the method of Claim 13.
26. A computer-readable medium having code embodied therein for causing an
electronic device to perform the method of Claim 14.
27. A computer-readable medium having code embodied therein for causing an
electronic device to perform the method of Claim 15.
28. A computer-readable medium having code embodied therein for causing an
electronic device to perform the method of Claim 16.

29. A computer-readable medium having code embodied therein for causing an electronic device to perform the method of Claim 17.

30. A computer-readable medium having code embodied therein for causing an electronic device to perform the method of Claim 18.

31. A computer-readable medium having code embodied therein for causing an electronic device to perform the method of Claim 19.

32. A computer-readable medium having code embodied therein for causing an electronic device to perform the method of Claim 20.

33. A computer-readable medium having code embodied therein for causing an electronic device to perform the method of Claim 21.

34. A computer-readable medium having code embodied therein for causing an electronic device to perform the method of Claim 22.

35. A computer-readable medium having code embodied therein for causing an electronic device to perform the method of Claim 23.

36. A computer-readable medium having code embodied therein for causing an electronic device to perform the method of Claim 24.

Evidence Appendix

None.

Related Proceedings Appendix

None.

If the Examiner has any questions or suggestions for expediting the prosecution of this application, the Examiner is requested to contact Applicant's attorney at (269) 279-8820.

Please charge any additional required fee or credit any overpayment not otherwise paid or credited to the credit card identified in the attached Form PTO-2038.

Respectfully submitted,

Date: 11/1/07

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